

REMARKS

Claims 1-17 are pending and under consideration. Claim 17 has been added. Support for claim 17 may be found in the claims as filed originally. Further reconsideration is requested based on the following remarks.

Interview Summary

The Applicants submit the following summary of the Office interview that took place November 1, 2006 between the undersigned representative of the Applicants and the Examiner.

Office Conference:

The Applicants thank the Examiner for the many courtesies extended to the undersigned representative of the Applicants during the interview that took place November 1, 2006.

Among the issues discussed during that interview were the patentability of the claims over the cited references, and, more particularly, the fact that none of the references cited to date disclose replacing "a parameter of the step information with a value of the parameter." The Examiner agreed graciously to withdraw the references cited upon receipt of the subject response. The Applicants appreciate the Examiner's willingness to reconsider the rejection, and look forward to further favorable consideration.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive. Further reconsideration is requested in view of the proceedings of the interview of November 1, 2006, and the following remarks.

Claim Rejections - 35 U.S.C. § 102:

Claims 1, 5, 9, and 13 were rejected under 35 U.S.C. § 102(a) as anticipated by the section of the subject application entitled "Background of the Invention," to which the final Office Action refers as "Applicant Admitted Prior Art," or "AAPA". The rejection is traversed to the extent it would apply to the claims as amended.

The background section of the subject application was published, at the *earliest*, on February 26, 2004, when the Office published the subject application as U.S. Patent Application Publication 2004-0039773 A1. For a reference to anticipate claims 1, 5, 9, and 13 under 35 U.S.C. § 102(a), on the other hand, it would have to have been published *before* the date of

invention, or by the July 31, 2003 filing date of the subject application at the *latest*. In particular, as provided by 35 U.S.C. § 102(a):

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

Since the section to which the final Office Action refers as AAPA was not published before the invention thereof by the applicant for patent as required by 35 U.S.C. § 102(a), the section to which the final Office Action refers as AAPA is not a valid reference under 35 U.S.C. § 102(a). Withdrawal of the rejection is earnestly solicited.

In any case, the fifth clause of claim 1 recites:

Executing steps specified by the step information in a way that replaces a parameter of the step information with a value of the parameter.

The section to which the final Office Action refers as AAPA neither teaches, discloses, nor suggests "executing steps specified by the step information in a way that replaces a parameter of the step information with a value of the parameter," as discussed during the interview held November 1, 2006. Installing Windows98 from a medium such as a CD-ROM etc in a way that *sets* the parameters saved in the definition file does not amount to "executing steps specified by the step information in a way that replaces a parameter of the step information with a value of the parameter," as recited in claim 1, contrary to the assertion in the final Office Action. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 5, 9, and 13:

The fifth clauses of claims 5, 9, and 13 recite substantially:

Executing steps specified by the step information in a way that replaces a parameter of the step information with a value of the parameter.

The section to which the final Office Action refers as AAPA neither teaches, discloses, nor suggests "executing steps specified by the step information in a way that replaces a parameter of the step information with a value of the parameter," as discussed above with respect to the rejection of claim 1. Claims 5, 9, and 13 are submitted to be allowable as well, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claims 5, 9, and 13 is earnestly solicited.

Claims 1, 2, 4, 5, 6, 8, 9, 10, 12, 13, 14, and 16:

Claims 1, 2, 4, 5, 6, 8, 9, 10, 12, 13, 14, and 16 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,117,186 to Wydall et al. (hereinafter "Wydall"). The rejection is traversed to the extent it would apply to the claims as amended.

The third clause of claim 1 recites:

Checking values of the parameters.

Wydall neither teaches, discloses, nor suggests "checking values of the parameters," as recited in claim 1.

The fourth clause of claim 1 recites:

When a checked result is correct, storing values of the parameters.

Wydall neither teaches, discloses, nor suggests "when a checked result is correct, storing values of the parameters," as recited in claim 1.

Wydall neither teaches, discloses, nor suggests "executing steps specified by the step information in a way that replaces a parameter of the step information with a value of the parameter," as recited in claim 1, either, as discussed during the interview held November 1, 2006. In Wydall, rather, the optimum size and/or frame rate is determined for this computer 2 by examining the operation of the computer 2 during playback of the video, not by "executing steps specified by the step information in a way that replaces a parameter of the step information with a value of the parameter," as recited in claim 1. In particular, as described at column 6, lines 60-67, continuing at column 7, lines 1-3:

If the CD-ROM program has not previously been used on this computer 2 (or if the CD-ROM program has been "uninstalled", e.g., the video parameters have been deleted from the hard disk 8), then a test video is loaded and played at full screen size (step 216). By examining the operation of the computer 2 during playback of the video, the optimum size and/or frame rate is determined for this computer 2 (step 218). This information is saved on the hard disk 8, e.g., in a cdnav.ini or the WIN.INI file, as discussed above (step 220) and the video is played back according to these parameters.

Since, in Wydall, the optimum size and/or frame rate is determined for this computer 2 by examining the operation of the computer 2 during playback of the video, Wydall is not "executing steps specified by the step information in a way that replaces a parameter of the step information with a value of the parameter," as recited in claim 1. Claim 1 is submitted to be allowable.

Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 2 and 4 depend from claim 1 and add additional distinguishing elements. Claims 2 and 4 are thus also submitted to be allowable. Withdrawal of the rejection of claims 2 and 4 is earnestly solicited.

Claims 5, 6, 8, 9, 10, 12, 13, 14, and 16:

The third clauses of claims 5, 9, and 13 recite substantially:

Checking values of the parameters.

Wydall neither teaches, discloses, nor suggests “checking values of the parameters,” as discussed above with respect to the rejection of claim 1.

The fourth clauses of claims 5, 9, and 13 recite substantially:

When a checked result is correct, referring to values of the parameters.

Wydall neither teaches, discloses, nor suggests “when a checked result is correct, referring to values of the parameters,” as recited in claims 5, 9, and 13.

Wydall neither teaches, discloses, nor suggests “executing steps specified by the step information in a way that replaces a parameter of the step information with a value of the parameter,” as discussed during the interview held November 1, 2006. Claims 5, 9, and 13 are submitted to be allowable as well, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claims 5, 9, and 13 is earnestly solicited.

Claims 6, 8, 10, 12, 14, and 16 depend from claim 5, claim 9, or claim 13 and add additional distinguishing elements. Claims 6, 8, 10, 12, 14, and 16 are thus also submitted to be allowable. Withdrawal of the rejection of claims 6, 8, 10, 12, 14, and 16 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 5, 7, 11, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wydall in view of U.S. Patent Publication No. 2002/0104019 to Chatani et al. (hereinafter “Chatani”). The rejection is traversed. Reconsideration is earnestly solicited.

Claims 7, 11, and 15 depend from claim 5, claim 9, and claim 13, respectively, and add additional distinguishing elements. Wydall neither teaches, discloses, nor suggests “checking values of the parameters,” “when a checked result is correct, referring to values of the parameters,” or “executing steps specified by the step information in a way that replaces a parameter of the step information with a value of the parameter,” as discussed above with respect to the rejection of claims 5, 9, and 13. Chatani does not either, and thus cannot make up for the deficiencies of Wydall with respect to the claimed invention. Claims 5, 7, 11, and 15

are thus also submitted to be allowable. Withdrawal of the rejection of claims 5, 7, 11, and 15 is earnestly solicited.

New Claim 17:

None of the cited references teach, disclose, or suggest "replacing a parameter of the step information with a value of the parameter by executing steps specified by the step information," as discussed during the interview held November 1, 2006. Claim 17 is thus believed to be allowable as well.

Allowable Subject Matter:

Since no specific grounds of rejection were lodged against claim 3, acknowledgement of the allowability of claim 3 is presumed.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-17 are allowable over the cited references. Allowance of all claims 1-17 and of this entire application is therefore respectfully requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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